

PATENT
Reply under 37 CFR 1.116
EXPEDITED PROCEDURE
Group 3731

REMARKS

Claims 1-10 are pending in this application. Claims 1-10 are rejected.

Responsive to the rejection of claims 1-10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,102,915 (Bresler et al.), Applicant respectfully traverses this rejection and submits that claims 1-10 are now in condition for allowance.

Bresler et al. '915 disclose milling tool 2 (Figs. 1-3) including a hollow, substantially hemispherical dome 3, with sharp-edged openings 4 and open base 50 in which are provided elements for removably fixing milling tool support 1 (column 3, lines 31-34). Dome 3 also has additional openings, such as openings 21 and 22, of sufficiently large size to enable the user to check the contact between the bottom of the cotyloid cavity hollowed out by milling tool 2 and the hemispherical external surface of milling tool 2 fitted into the cavity (column 4, lines 12-17). Muller et al. '634 disclose a medullary drill head (Figs. 1-4) including shell 6 having three openings 5 in the form of spirally shaped slots, placed 120° apart as shown in Fig. 2.

In contrast, claim 1 recites in part:

each said viewing window including an axis both extending through a corresponding said viewing window and orthogonal to said distal face, at least one said viewing window including at least one convex segment as viewed from a corresponding said axis, said at least one convex segment located on a perimeter of the corresponding said viewing window.

(Emphasis added.) Applicant submits that such an invention is neither taught, disclosed nor suggested by Bresler et al. '915 or any of the other cited references, alone or in combination, and has distinct advantages thereover.

Applicant respectfully submits that the Examiner is relying on a digitally enhanced version of Fig. 3 of Bresler et al. '915, and the particular feature that the Examiner points to in this digitally enhanced version of Fig. 3 of Bresler et al. '915, at page 3 of the Office Action, is an

SMI0029.US

PATENT
Reply under 37 CFR 1.116
EXPEDITED PROCEDURE
Group 3731

artifact of the digital enhancement. Secondly, placing a straightedge through the alleged "convex segment" of the drawing at page 3 of the Office Action, confirms that the segment is actually straight, or concave. More specifically, Applicant submits that a straightedge (see line 10, Attachment A) can be simultaneously placed through all of the centerpoints of the pixels of the alleged "convex segment" of the drawing at page 3 of the Office Action, which confirms that the alleged "convex segment" is actually straight. Further, a straightedge (see line 10, Attachment A) simultaneously placed through all of the centerpoints of the pixels of the alleged "convex segment" of the drawing at page 3 of the Office Action also distinctly shows equal amounts of the alleged "convex segment" on either side of the straightedge which further confirms that the alleged "convex segment" is actually straight. Thirdly, the newly created drawing at page 3 of the Office Action is not prior art under 35 U.S.C. § 102(b), as the Examiner alleges, since its publication date is the March 17, 2004 date of the Office Action and therefore does not have a publication date one year prior to the U.S. filing date of the present application as required by 35 U.S.C. § 102(b). Yet further, the newly created drawing at page 3 of the Office Action does not qualify as a prior art printed publication. To qualify as a prior art printed publication, there must be "a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." (MPEP 2128). As pending patent applications are held in strict confidence at the USPTO, the newly created drawing at page 3 of the Office Action should not have been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it as required by MPEP 2128.

Applicant respectfully submits that the Examiner's arguments at page 3 of the Office

SMI0029.US

PATENT
Reply under 37 CFR 1.116
EXPEDITED PROCEDURE
Group 3731

Action are in error in that the Examiner has apparently ignored the illustration of Attachment A (again attached herewith in Attachment A of this response) in the response filed June 10, and is further ignoring the claim limitations of:

... each said viewing window including an axis both extending through a corresponding said viewing window and orthogonal to said distal face, at least one said viewing window including at least one convex segment as viewed from a corresponding said axis, said at least one convex segment located on a perimeter of the corresponding said viewing window.

To anticipate a claim, the reference must teach every element of the claim (MPEP 2131), and Bresler et al. '915 fails to disclose or suggest at least the above mentioned claim limitations; therefore, Bresler et al. '915 does not anticipate the present invention. Yet further, Applicant respectfully submits that the Examiner's assertion that the newly created drawing at page 3 of the Office Action was not altered except in size, versus Fig. 3 of Bresler et al. '915, is also in error. Placing Fig. 3 of Bresler et al. '915 under a magnification glass clearly shows no digital enhancement as is apparent in the newly created drawing at page 3 of the Office Action.

An advantage of the present invention is the convex circumferential segments of the present invention bulge into the viewing windows (see Figs. 2 and 3 in the application as filed) and in use, as the reamer rotates and cuts, the convex circumferential segments will tend to shed cut biomatter and therefore maintain an open window. This provides an advantage over the prior art including Bresler et al. '915, which only disclose straight or concave sections as viewed from inside the corresponding opening, the straight or concave sections not shedding cut biomatter as efficiently as the present invention. Further, the convex circumferential segments of the present invention allow greater flexibility in the shape of the viewing windows when compared to the openings of the prior art. Yet further, the convex circumferential segments of the present invention allow the viewing windows to be contoured around cutting teeth having concave

SMI0029.US

PATENT
Reply under 37 CFR 1.116
EXPEDITED PROCEDURE
Group 3731

sections (see again Figs. 2 and 3), thereby maximizing the viewing window aperture area while simultaneously maintaining the strength of the reamer by keeping sufficient material between the viewing windows and the cutting teeth.

Further, claim 9 has been previously amended, similarly to claim 1, to recite in part: "at least one said viewing window including at least one convex segment as viewed from a corresponding said axis, said at least one convex segment located on a perimeter of the corresponding said viewing window.".

For all of the foregoing reasons, Applicant submits that claims 1 and 9, and claims 2-8 and 10 depending therefrom, are now in condition for allowance, which is hereby respectfully requested.

For the foregoing reasons, Applicant submits that no combination of the cited references teaches, discloses or suggests the subject matter of the amended claims. The pending claims are therefore in condition for allowance, and Applicant respectfully requests withdrawal of all rejections and allowance of the claims.

In the event Applicant has overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicant hereby conditionally petitions therefor and authorizes that any charges be made to Deposit Account No. 20-0095, TAYLOR & AUST, P.C.

SMI0029.US

PATENT
Reply under 37 CFR 1.116
EXPEDITED PROCEDURE
Group 3731

Should any question concerning any of the foregoing arise, the Examiner is invited to
telephone the undersigned at (260) 897-3400.

Respectfully submitted,



Stephen D. Horchem
Registration No. 53,035

SDH/ar

TAYLOR & AUST, P.C.
142 S. Main Street
P.O. Box 560
Avilla, IN 46710
Telephone: 260-897-3400
Facsimile: 260-897-9300

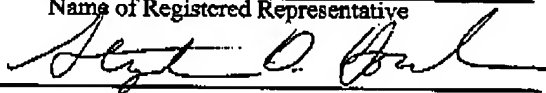
Agent for Applicant

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being transmitted via facsimile
to the U.S. Patent and Trademark Office, on: February 11, 2005.

Stephen D. Horchem, Reg. No. 53,035

Name of Registered Representative



Signature

February 11, 2005

Date

SMT0029.US